



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,680	04/17/2000	GERHARD WOTTING	MO-5599/LEA3	1031

7590 09/11/2002

BAYER CORPORATION
100 BAYER ROAD
PITTSBURGH, PA 15205-9741

EXAMINER

GROUP, KARL E

ART UNIT	PAPER NUMBER
----------	--------------

1755

16

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-16

Office Action Summary

Application No.
09/529,680

Applicant(s)
Wotting et al

Examiner
Karl Group

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 21, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1755

1. The request filed on 8-21-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/529680 is acceptable and a CPA has been established. An action on the CPA follows.
2. The marked up version of the amended claim 12 is incorrect (note claim depends upon itself). Correction is required for the amendment to be entered. The amendment to claim 12 has not been entered.
3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 4-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims a ratio may not be given in a percentage.

Claim 12 "the reactive additive" lacks antecedent basis. It should be noted page 3 of the disclosure does not list the compounds of claim 12 as reactive additives but additives that form a disperse phase. Merely removing "reactive" and maintaining dependency on claim 11 will overcome this rejection. Also not claim 22 should also be changed because "reactive" lacks antecedent basis.

Claims 4 and 14, "the oxide nitride" lacks antecedent basis. Also it is not clear what phase applicants are attempting to claim because it does not appear that "ON" can be a phase. Also the "< 1%" lacks what the percentage is based upon such as weight or molar.

Art Unit: 1755

Claims 5 and 15 , there should be an “and” before “alkaline earth”.

5. The disclosure is objected to because of the following informalities: The specification lacks a brief description of drawings..

Appropriate correction is required.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 4-23 are rejected under 35 U.S.C. 102(e or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hintermayer US 5,998,319 or PCT WO 97/21644..

The priority date is not before the publication dates of the above documents.

8. Claims 4-23 are rejected under 35 U.S.C. 102(a or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al, for reasons of record.

Examples 1 and 17 fall squarely within the instant claims. Furthermore it is clear that there is a grain boundary phase present in Sato et al, see column 3, lines 1-17.

Furthermore the ranges of the components set forth in Sato et al overlap the claimed molar ratio. It is taught by Sato et al that the strength of the sintered body is improved with the addition of silicon dioxide, see column 3, lines 35-52.

The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed

Art Unit: 1755


by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549.

The instant claims are devoid of a limitation drawn to the elimination of a silicon oxynitride phase.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Group whose telephone number is (703)308-3821. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703)308-3823. The fax phone number for this Group is (703)872-9310, for any non-final amendment or communication, and (703)872-9311 for any after-final amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.


KARL GROUP
PRIMARY EXAMINER
ART UNIT 1755

Keg
September 10, 2002